

REMARKS / DISCUSSION OF ISSUES

In the final Office action dated December 8, 2009, claims 33-60 are pending in the application. Claims 33, 47, and 60 are independent. Claims 1-32 were previously canceled.

35 U.S.C § 112

Claims 47-59 stand rejected under 35 U.S.C § 112, second paragraph as allegedly being indefinite. The Office action alleges that claims 47-59 recite the phrase "means for" but are modified by some structure, material, or acts recited in the claim.

MPEP section 2181(I) recites:

A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for;"
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

The Applicants respectfully submit that claims 47-59 satisfy the requirements of 35 U.S.C. 112, sixth paragraph and MPEP section 2181(I). For example, claim 47 recites:

A system for generating an Authorized Domain, comprising:
 means for obtaining a domain identifier uniquely identifying the Authorized Domain;
 means for binding at least one user to the domain identifier;
and
 means for binding at least one device to at least one user by obtaining or generating a Device Owner List comprising a unique identifier for a user and a unique identifier for each device belonging to the user thereby defining that the at least one device is bound to the user, or by obtaining or generating a Device Owner List for each device to be bound, the Device Owner List comprising a unique identifier for a user and a unique identifier for a device

belonging to the user thereby defining that the device is bound to the user, thereby obtaining a number of devices and a number of persons that is authorized to access a content item of said Authorized Domain.

The Office action at pages 2 and 5 does not specifically point out or even suggest how the alleged structure in the claim is sufficient for performing the “obtaining” and “binding” functions. Instead, the Office action merely provides a conclusory statement that “[t]he claim limitations contain structure to allow one of ordinary skill in the art to perform the claimed invention. Applicants point out that this is not the test per MPEP section 2181(I). Section (C) recites: the phrase “means for” or “step for” must not be modified by sufficient structure, material, or acts for achieving the specified function (emphasis added). Applicants respectfully contend that the Office has not met the burden of a showing required to reject the claims.

Claim 60 stands rejected under 35 U.S.C § 112, second paragraph as allegedly being indefinite. The Office action alleges that the term “computer readable storage medium” has not been defined in the specification, and that it is allegedly unclear whether or not a computer readable storage medium can include a signal.

The Applicants respectfully point out that a computer readable storage medium is referenced throughout the specification as originally filed. For example, page 7, lines 13-15 recite, “[f]urther, the invention also relates to a computer readable medium having stored thereon instructions for causing one or more processing units to execute the method according to the present invention.” Also, page 12, lines 13-15 recite, “[c]ontent rights might also be stored together with the content on for example an optical disk.”

The specification does not suggest that a computer readable storage medium can include a signal and Applicants neither actively nor passively sought to encompass ‘transmission medium (or media)’ or ‘carrier wave’ within the meaning of computer readable medium. The Office is directed to BPAI *Ex parte* Daughtrey, Decided: July 31, 2009.

35 U.S.C § 101

Claim 60 stands rejected under 35 U.S.C § 101 because the claimed invention is allegedly directed to non-statutory subject matter. The Office action at pages 3 and 6 allege that the specification has not specifically defined the term “computer readable storage medium” and therefore can be considered to include mediums such as signals.

A computer-readable medium is an article of manufacture and one of the statutory categories of subject matter under § 101. Both the Federal Circuit as well as MPEP § 2106.01 have deemed a computer-readable medium tangible and statutory.

The Office is directed to BPAI cases *Ex parte Stanley Bruce Holmstead and Jody L. Terrill*, Decided: May 20, 2009. In *Ex parte Stanley Bruce Holmstead and Jody L. Terrill*, the Panel reversed the Examiner’s 101 rejection and held that the Appellant’s claimed computer-readable medium, when interpreted in light of the Specification, fully comports with statutory subject matter.

The specification does not disclose or suggest that the computer readable storage medium can include a signal. The Office is again directed to BPAI *Ex parte Daughtrey*, Decided: July 31, 2009. Therefore, in accordance with the BPAI and in light of the Applicants’ specification as originally filed, the Applicants respectfully submit that the claimed “computer readable storage medium” is directed to statutory subject matter and that the rejection under 101 should be withdrawn.

35 U.S.C § 102

Claims 33-35, 37-49, and 51-60 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by US Publication Number 2003/0018491 to Nakahara et al. (hereinafter referred to as “Nakahara”). The Applicants respectfully traverse these rejections.

In order for a reference to anticipate a claim, MPEP 2131 requires the reference to teach every element of the claim. According to MPEP 2131, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920

(Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

It is respectfully submitted that the Office action failed to establish a prima facie case of anticipation.

The Applicants' independent claim 33 recites,

A method of generating an Authorized Domain (AD), comprising:
selecting a domain identifier uniquely identifying the Authorized Domain;
binding at least one user to the domain identifier; and
binding at least one device to at least one user by obtaining or generating a Device Owner List comprising a unique identifier for a user and a unique identifier for each device belonging to the user, thereby defining that the at least one device is bound to the user, or in that the binding of at least one device to at least one user comprises obtaining or generating a Device Owner List for each device to be bound, the Device Owner List comprising a unique identifier for a user and a unique identifier for a device belonging to the user, thereby defining that the device is bound to the user, thereby obtaining a number of devices and a number of users that is authorized to access a content item of said Authorized Domain. Emphasis added.

The Office action at pages 3-4 in the response to arguments section, and also at pages 7-8 alleges that Nakahara at paragraphs [0200] and [0201] discloses every element of the Applicants' claim 33.

The Applicants have fully considered Nakahara in its entirety and respectfully present five independent and mutually exclusive arguments that Nakahara does not anticipate claim 33.

First, the Applicants' claim 33 includes the limitation of selecting a domain identifier uniquely identifying the Authorized Domain.

The Office action at page 7 alleges that Nakahara at paragraph [0200] discloses selecting a domain identifier uniquely identifying the Authorized Domain ("Nakahara, paragraph 200, teaches having a domain list that identifies the authorized devices.") The Applicants respectfully traverse this allegation.

Nakahara at paragraph [0200] discloses a domain list method wherein each of the license management units holds a domain list in which the function IDs of the function units of the content usage devices that belong to the user domain. However, a domain list is not a unique identifier. A domain list is merely a list of function IDs of the function units. Furthermore, a domain list that identifies devices would not be considered by one of ordinary skill in the art to be identical to a domain identifier uniquely identifying an Authorized Domain because the device of Nakahara is not the same or equivalent to the Authorized Domain of the claimed invention.

Nowhere does Nakahara teach selecting a domain identifier uniquely identifying the Authorized Domain. Accordingly, Nakahara does not teach every element of claim 33 and therefore does not anticipate claim 33. As such, the 102 rejection to claim 33 should be withdrawn.

Second, claim 33 requires binding at least one user to the domain identifier.

The Office action at pages 7 and 8 alleges that Nakahara at paragraph [0200] disclose these limitations ("Nakahara, paragraph [200], teaches searcher X being a user," and "the authorized devices (of Nakahara) being on the domain list.") Also, at pages 3 and 4 the Office maintains that Nakahara allegedly teaches a domain list is generated by a user and only a specific user can have access to the domain list because the domain list is password protected, and a user is therefore allegedly bound to the domain list. The Applicants respectfully rebut these arguments.

As explained above, Nakahara does not disclose selecting a domain identifier uniquely identifying the Authorized Domain. Since Nakahara does not disclose a domain identifier, then Nakahara logically does not disclose binding at least one user to the domain identifier, as required in claim 33. Therefore, Nakahara does not anticipate claim 33.

Furthermore, the Applicants respectfully submit that Nakahara's "searcher X" is not a "user," and thus Nakahara does not disclose binding at least one user to the domain identifier.

Nakahara at paragraph [0120] makes very clear that ". . . searcher X is any of license management units 1a, 2a, and 3a and the content output units 1b, 2b, 3b,

and 4b. . . .” This context of “searcher X” is consistently repeated throughout Nakahara in its entirety. For example, see paragraphs [0163], “. . . when the searcher X is a license management unit. . . ,” [0166], “. . . the content output units 1b, 2b, 3b and 4b that is to be the searcher X,” [0172], “. . . when the searcher X is any of the content output units 1b, 2b, 3b and 4b,”

Nakahara at paragraphs [0199] and [0200] discloses how each license management unit determines whether the searcher X that requests the license information belongs to the user domain identical to the user domain to which the license management unit belongs. This does not mean that the searcher X is a user. At [0200] and throughout Nakahara in its entirety, “searcher X” is either a license management unit or a content output unit.

Nowhere throughout Nakahara is “searcher X” considered to be a user. Nakahara’s disclosure is completely different from the Applicants’ claimed invention because Nakahara does not disclose the limitation of binding at least one user to the domain identifier, as set forth in the Applicants’ claim 33. Although Nakahara at [0197] may disclose different usage restrictions may be put on a content usage device 1 for a father’s usage and a content usage device 2 for his son’s usage, and at [0226] apparently discloses user IDs for identifying users that may be registered in advance in association with the function unit IDs, Nakahara does not bind a user to a domain identifier of an Domain. Nakahara’s disclosure in its entirety appears to be directed towards the transfer of server, device, and content information to and from the license management unit, but does not include or suggest the transfer of user information. Therefore, Nakahara is completely different from the Applicants’ claimed invention because Nakahara does not disclose, teach, or even suggest binding at least one user to the domain identifier, as required in the Applicants’ claim 33.

Third, claim 33 requires binding at least one device to at least one user by obtaining or generating a Device Owner List comprising a unique identifier for a user and a unique identifier for each device belonging to the user, thereby defining that the at least one device is bound to the user.

The Office action on page 8 repeats the citation of Nakahara at paragraph [0200] as allegedly disclosing these limitations.

Nakahara at [0200] discloses a domain list method in which license management units reportedly hold a domain list in which the function IDs of the function units of the content usage devices that belong to the user domain identical to that of its own. Although the domain list of Nakahara comprises IDs of the function units of content usage devices, nowhere does Nakahara disclose defining that the device is bound to the user. Thus, Nakahara does not anticipate claim 33.

Fourth, claim 33 includes the limitation of the Device Owner List comprising a unique identifier for a user.

The Office action on page 8 repeats the citation of Nakahara at paragraph [0200] as allegedly disclosing this limitation.

Nakahara at [0200] discloses a domain list method in which license management units reportedly hold a domain list in which the function IDs of the function units of the content usage devices that belong to the user domain identical to that of its own. Although the domain list of Nakahara comprises IDs of the function units of content usage devices, nowhere does Nakahara disclose that the domain list also includes a unique identifier for a user. As such, claim 33 is not anticipated by Nakahara.

Fifth, claim 33 requires obtaining a number of devices and a number of users that is authorized to access a content item of said Authorized Domain.

The Office action on page 8 repeats the citation of Nakahara at paragraph [0200] as allegedly disclosing this limitation. However, nowhere does Nakahara disclose obtaining a number of devices and a number of users that is authorized to access a content item of said Authorized Domain. Accordingly, claim 33 is not anticipated by Nakahara.

The Applicants respectfully submit that any one of the five arguments as presented above successfully traverses the rejection of claim 33 under 35 U.S.C. §102(b) and as such, the rejection should be withdrawn.

Independent claims 47 and 60, although different from claim 33, include several distinguishing limitations which Applicants apply the above arguments from claim 33. For example, claim 47 is directed to a system for generating an Authorized Domain and includes in part “means for binding at least one device to at least one user by obtaining or generating a Device Owner List,” and claim 60 is directed to a computer readable storage medium and includes in part “binding at least one device to at least one user by obtaining or generating a Device Owner List.”

The Office action uses the same arguments as set forth with regard to claim 33, alleging that independent claims 47 and 60 are anticipated by Nakahara. The Applicants repeat the above arguments for claim 33 and apply them to the specific features recited in independent claims 47 and 60. As such, the Applicants respectfully submit that claims 47 and 60 are not anticipated by Nakahara and respectfully request the withdrawal of the rejection.

Dependent claims 34, 35, 37-46, 48, 49, and 51-59 ultimately depend upon and incorporate all the limitations of either one of allowable claims 33 and 47. Furthermore, each dependent claim includes additional distinguishing limitations. For each dependent claim, the Applicants repeat the above arguments from claim 33 and apply them to the respective dependent claim. Thus, the Applicants respectfully submit that dependent claims 34, 35, 37-46, 48, 49, and 51-59 are allowable at least by virtue of their dependency on an allowable parent claim.

The Applicants respectfully submit that the rejection of claims 33-35, 37-49, and 51-60 under 35 U.S.C. §102(b) has been traversed and should be withdrawn.

Rejections under 35 U.S.C § 103

Dependent claims 36 and 50 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nakahara. The Applicants respectfully traverse this rejection.

Dependent claims 36 and 50 depend ultimately upon allowable claims 33 and 47, respectively, and incorporate all of the limitations of the claim from which they depend, in addition to containing further distinguishing patentable subject matter.

The Applicants repeat the above arguments from claim 33 and apply them to claims 36 and 50. Thus, the Applicants respectfully submit that dependent claims 35 and 50 are allowable at least by virtue of their dependency on an allowable parent claim.

Additionally, MPEP 2142 states:

"[r]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 R.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2c 1385, 1396 (2007) (quoting Federal Circuit statement with approval).

The Office action at page 13 simply provides a conclusory statement that it would be obvious to one of ordinary skill in the art to provide Nakahara's Authorized Domain size limitation, where the limitation relates to a maximum number of users. The Office does not provide any explanation or supporting evidence as to why one of ordinary skill in the art would understand why Nakahara's disclosure would also apply to the method for generating an Authorized Domain as claimed. As pointed out above, Nakahara is completely different as compared to the Applicants' system and method for generating an Authorized Domain. No explanation at all is provided as to how this conclusion was reached. The only ground being provided is the Examiner's conclusory statement.

KSR makes clear that rejections on obviousness cannot be sustained by mere conclusory statements; instead KSR requires that an Examiner provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." (KSR Opinion at p. 14). An Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," (KSR Opinion at p. 15). And, the Examiner must make "explicit" this rationale of "the apparent reason to combine the known elements in the fashion claimed," including a detailed explanation of "the effects of demands known to the design community or present in the marketplace" and "the background knowledge possessed by a person having ordinary skill in the art." (KSR Opinion at p. 14). Anything less than such an explicit

analysis may not be sufficient to support a prima facie case of obviousness.

Therefore, the Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. 103(a).

Hence, the withdrawal of the rejection to dependent claims 35 and 50 under 35 U.S.C. § 103(a) and early allowance is respectfully requested.

Conclusion

In view of the foregoing, the Applicants respectfully request that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 14-1270.

Respectfully submitted,

By: /Brian S. Myers/
Brian S. Myers
Registration No.: 46,947
973-401-7157
For: Kevin C. Ecker
Registration No.: 43,600
914-333-9618

Please direct all correspondence to:
Kevin C. Ecker, Esq.
Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510-8001